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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,093	07/06/2001	Koji Iketani	10417-088001	4450

7590

07/25/2002

SAMUEL BORODACH

Fish & Richardson P.C.

Suite 2800

45 Rockefeller Plaza

New York, NY 10111

EXAMINER

TOLEDO, FERNANDO L

ART UNIT

PAPER NUMBER

2823

DATE MAILED: 07/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/900,093

Applicant(s)

IKETANI ET AL.

Examiner

Fernando Toledo

Art Unit

2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following reason:

It is noted that there are number of co-pending applications filled related to the instant application. However, the applicant fails to disclose the co-pending applications that related to the instant application as required under 37 CFR 1.56. "Information relating to or from co-pending United States Patent applications, the individuals covered by 37 CFR 1.56 have a duty to bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other co-pending United States applications which are "material to patentability" of the application in question. As set forth by the court in *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 (7th Cir. 1972)." Therefore, applicant is requested to provide the serial numbers of all the co-pending application that related to the instant application.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

3. Applicant is advised that should claims 1 – 8 be found allowable, claims 10 – 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

Art Unit: 2823

one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

### ***Double Patenting***

4. Claims 1 – 16 of this application conflict with claims 1 – 6 of Application No. 09/911924. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 – 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 6 of copending Application No. 09/911924. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious that the adhesive

Art Unit: 2823

layer will have to be peeled off in order to separate the semiconductor chips from one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1 – 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tani et al. (U. S. patent 6,368, 893 B1).

In re claims 1 and 9, Tani discloses in the U. S. patent 6,36,893 B1; figures 1 – 9B and related text, fixing semiconductor chips 33 onto a substrate 21; covering the semiconductor chips fixed onto the substrate with a common resin layer 35; cutting the substrate and the resin layer in a state that the adhesive sheet is glued to the resin layer (figure 8B).

Tani does not explicitly shows measuring the semiconductor devices in a stat that the adhesive sheet is glued to the resin layer.

However, it is inherent absent to evidence to the contrary that the devices are measured (i.e. tested) prior to packaging.

In re claim 9, Tani shows peeling the resin layer from the adhesive sheet after performing the measurement of the semiconductor devices (column 5); and directly storing the semiconductor device peeled from the adhesive in a carrier tape (columns 5 and 6).

In re claims 2 and 10, Tani discloses wherein the substrate and the resin layer is cut from the reverse surface of the substrate in a state that the adhesive sheet is glued to the resin layer (figure 8B).

In re claims 3 and 11, Tani discloses wherein the substrate and the resin layer which are cut are integrally supported by the adhesive layer (figure 8B).

In re claims 4 and 12, Tani discloses wherein the substrate and the resin layer is cut by performing dicing in a stat that the adhesive sheet is glued to the resin layer (figure 8B).

In re claims 5 and 13, Tani discloses wherein external electrodes 31 are provided on the reverse side of the substrate and electrically connected to the semiconductor chips.

In re claims 6 and 14, Tani discloses flattening the surface of the resin layer after covering the semiconductor chops with the resin layer (figure 7C).

In re claims 7 and 15, Tani discloses wherein the circumferential edge of the adhesive sheet is fixed to a metal frame (column 4).

Art Unit: 2823

In re claims 8 and 16, Tani discloses wherein several substrates are glued to the adhesive sheet (figure 7A).

**Conclusion**

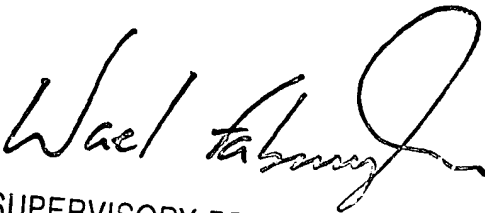
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fernando Toledo whose telephone number is (703) 305-0567. The examiner can normally be reached on Monday – Friday, 8am – 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703) 308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

	Fernando Toledo Patent Examiner Art Unit 2823
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ft  
July 22, 2002

  
SUPERVISORY PRIMARY EXAMINER  
TECHNOLOGY CENTER 2000